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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,456	08/26/2003	Donald E. Godshaw	04286.00124	5091
22908 7590 04/11/2007 BANNER & WITCOFF, LTD. TEN SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606			EXAMINER LARSON, JUSTIN MATTHEW	
			ART UNIT	PAPER NUMBER
			3782	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/11/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/648,456

Applicant(s)

GODSHAW ET AL.

Examiner

Justin M. Larson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 2-4,9-12 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-8,13,14 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 5-8, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 6,305,587 B1) in view of Kepper (US 2,729,257 A).

Regarding claims 1 and 5, Miller discloses a foldable luggage bag (Figure 9) comprising, in combination: a first lesser capacity flexible partial bag made from a flexible, foldable material (plastic fabric, ballistic nylon, col. 5 lines 52-55) and including an outside surface with a front panel (22) and a periphery opposite said front panel with a first closed loop peripheral fastening mechanism (zipper 102) extending around the periphery, a side panel (28) between the front panel and the periphery defining a first bag interior; and a second flexible partial bag made from a flexible, foldable material and of greater capacity than the first, said second bag attached to the first bag and extending from the periphery of the first bag with the first peripheral fastening mechanism maintained on the first bag outside surface to enable forming a bag enclosure comprised of the volume of the first bag and a portion of the second bag, said second bag further including a second closed loop fastening mechanism (102) on the second bag outside surface, said second fastening mechanism encircling said portion of said second bag and having the same length as the first fastening mechanism and also

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fully attachable along its length to the first fastening mechanism, said second fastening closed loop mechanism subtending the front panel of the first partial bag upon the unfolding of said first and second bags whereby the first fastening mechanism and the second fastening mechanism may be connected along their entire closed loop length to enclose the second bag within a volume comprised of the first bag and said part of the second bag encircled by the second fastening mechanism, said first partial bag having less capacity than the second partial bag, and said second partial bag including a separate access opening (132).

Miller fails to disclose there being an opening in the first partial bag lying opposite the front panel of the first partial bag, wherein the opening provides access from the second partial bag into the first partial bag and vice versa such that when the second partial bag is collapsed into its storage position, it can be partially stored within the first partial bag due to the opening between the two. Instead, Miller discloses a dividing panel (72) separating the volumes of each bag that inherently prevents a user from accessing both partial bags through either of the access openings (100, 132).

Regarding the opening, Kepper teaches that when a convertible bag comprises two bag portions, the panel separating the respective volumes of the first and second bag portions may be detachable, allowing a user to access both of the bag portions' interiors through a single opening. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the luggage bag of Miller by making wall (72) detachable, as taught by Kepper, in order to allow a user to store larger objects, objects that would otherwise be too large to store within the volume of a

single bag, in a combination of the both of the bags' volumes, increasing the utility of the luggage bag.

Regarding the second partial bag being partially stored within the first bag, the detachable wall implemented on the Miller bag device would allow the second bag to be partially stored within the first partial bag, effectively satisfying this limitation in the claims.

Regarding claim 6, the second partial bag of the modified Miller bag comprises an enclosed bag with a bottom panel, a front panel including the first partial bag, a back panel spaced from the front panel, a connecting top and side panel (126) joined to the bottom panel, back panel, and the front panel, and at least one back strap (120) attached to the back panel.

Regarding claims 7 and 8, the modified Miller bag includes first and second spaced adjustable back straps (120) attached to the back panel.

Regarding claims 9 and 10, the modified Miller bag includes an access mechanism (zipper 100) in the first partial bag.

Regarding claim 14, the first partial bag of the modified Miller bag device is positioned intermediate the top and bottom of the second partial bag.

Regarding claim 16, the modified Miller bag device includes the claimed features except for the particular size relationship between the first and second partial bags. The first bag of Miller appears to be more than 25% of the volume of the second bag. It would, however, have been an obvious matter of design choice to make the first bag smaller, since such a modification would have involved a mere change in the size of a

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component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). To make the first bag of the modified Miller bag device smaller would not take away from the original function of the modified Miller bag device.

3. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller in view of Kepper as applied above, and further in view of Bendersky (US 5,255,834 A).

The modified Miller luggage bag includes the claimed features except for there being a display on the outside surface of the first bag. Bendersky, however, teaches that it is old and well known in the art to provide displays on the outside of bags/packs. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an image or display on the outside of the first bag, as taught by Bendersky, in order to provide an aesthetically appealing bag/pack to suit various consumer tastes.

#### ***Response to Arguments***

4. Applicant's arguments filed 3/13/07 have been fully considered but they are not persuasive.

Applicant has asserted that the combination of Miller and Kepper is improper because the intent of Miller is to provide a computer compartment separate from the first partial bag, the computer compartment including padding on all sides of the compartment. Examiner notes that in the combination set forth above, the only modification made to Miller was to make the separating panel (72) detachable. After the modification, there would still be padded surfaces on all sides of the computer

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compartment when the panel was attached in its original location. If a user wanted to store a computer in the computer compartment, the computer would be separated from the rest of the bag, as originally taught by Miller. If the user did not want to carry a computer, however, the panel (72) could be detached, as taught by Kepper, so that the user could store larger items in the volume of the entire bag without having separated compartments. The original functionality of the Miller bag would not be modified when making the separating panel (72) detachable as taught by Kepper. It would maintain the original functionality of the bag and would also increase the bag's utility in that larger items could be stored in the pack.

Applicant has asserted that neither Miller nor Kepper discloses a second partial bag being stored within the interior of a first partial bag. Examiner notes that the limitations of claim 1 directed to this feature are only functional. The initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over the modified Miller bag which is capable of being used in the intended manner, i.e., the first fastening mechanism (102) and the second fastening mechanism (102) being connected along their entire closed loop length to enclose the second bag within said first bag interior. There is no structure in the modified Miller bag that would prohibit such functional intended use (see MPEP 2111). The second partial bag of the modified Miller bag, in the presence of a detachable panel (72), as taught by Kepper, is certainly capable of being enclosed within the first bag interior when the panel (72) is detached. With the panel

(72) detached, there is nothing stopping the second partial bag of the modified Miller bag from entering the first partial bag.

***Conclusion***

5. The prior art made of record and not relied upon teaches that it is well known in the art for plastic fabric or ballistic nylon to be a flexible, foldable material.

6. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571) 272-8649. The examiner can normally be reached on Monday - Thursday, 7am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JML  
11/28/06

  
NATHAN J. NEWHOUSE  
SUPERVISORY PATENT EXAMINER